

REPLY UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 2600
Docket No. 1101.0112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sung-hee HWANG et al.

Application No. 10/765,954

Group Art Unit: 2627

Confirmation No. 2323

Filed: January 29, 2004

Examiner: Tan X. Dinh

For: WRITE-ONCE OPTICAL DISC HAVING UPDATE AREA AND ACCESS AREA (As Amended)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is in response to the Final Office Action mailed March 9, 2010, and having a period for response set to expire on June 9, 2010, and the Advisory Action mailed May 26, 2010, indicating that the Amendment in Response to Final Office Action of May 11, 2010, will be entered for purposes of appeal.

Pursuant to 1296 OG 67 and 1303 OG 21, the applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal as required by section 2 of 1296 OG 67.

The review is requested for the reasons set forth on the following pages, of which only five pages (i.e., pages 2-6) are arguments as required by section (3)(b) of 1296 OG 67. Page 7 is a signature page.

REMARKS

Claims 1, 4, 22-24, and 43 are pending, with claims 1, 22, and 43 being independent.

Claims 1, 4, 22-24, and 43 have been rejected under 35 USC 102(b) as being unpatentable over Ito et al. (Ito) (U.S. Patent No. 6,160,778). The Office did not provide an explanation of this rejection in the Final Office Action of March 9, 2010, but stated "[t]he rejection of claims **1,4,22-24 and 43** are [sic] repeated herein," presumably referring to the explanation of this rejection set forth on pages 3 and 4 of the Office Action of August 31, 2009.

The Board of Patent Appeals and Interferences states as follows in *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990), at 1462 (emphasis added):

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed combination. (Citations omitted.) Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. (Citation omitted.)

On pages 3 and 4 of the Office Action of August 31, 2009, the Office states as follows:

ITOH [sic] et al [sic] discloses a write-once disc with at least one record layer, as claimed in claim 1, comprising:

at least one temporary defect management area in which temporary management information including temporary defect information and temporary defect management information are recorded, the temporary defect information comprising position information of a defect area and position information of a replacement area for replacing the defect area (Fig.1D, location of defective sector 22b and location of replacement sector 22c), the temporary defect management information comprises an [sic] pointer indicates [sic] an area which [sic] temporary defect information is recorded (Fig.1C, status information 22a. In this case the status information indicates the location of defective sector 22b and location of replacement sector 22 [sic] 22c. See column 10, line 30 to column 11, line 37) ;

an access information area in which location information is recorded, the location information regarding an area in which the temporary management information is recorded (Fig.1A, the access information area is disk information area 4) .

However, the Office has not identified the elements in Ito that it considers to correspond to the "temporary defect management area" recited in claim 1, or the "temporary management

information" recited in claim 1, or the "location information regarding an area in which the temporary management information is recorded" recited in claim 1, such that the Office has not identified wherein these facets of claim 1 are disclosed in Ito as required by *Levy*. Furthermore, it is submitted that these facets of claim 1 are not disclosed or suggested by Ito, particularly since the word "temporary" does not appear in Ito.

Arguments similar to the above arguments were also presented in the last paragraph on page 7 and the first paragraph on page 8 of the Amendment in Response to Final Office Action of May 11, 2010, but the Office did not take note of these arguments and answer the substance of them in the Advisory Action of May 26, 2010, as required by MPEP 707.07(f).

Furthermore, although the Office considers the disk information area 4 in FIG. 4 of Ito to be "an access information area" as recited in claim 1, it is submitted that Ito does not disclose or suggest that location information of any kind is recorded in the disk information area 4, let alone "location information regarding an area in which the temporary management information is recorded" as recited in claim 1.

The Office apparently considers the location information fields 22b and 22c of the SDL (secondary defect list) entry 22 in FIGS. 1D and 2 of Ito to be "temporary defect information comprising position information of a defect area and position information of a replacement area for replacing the defect area" as recited in claim 1, and apparently considers the status field 22a of the SDL entry 22 in FIGS. 1C and 2 of Ito to be "temporary defect management information comprising a pointer indicating an area in which the temporary defect information is recorded" as recited in claim 1. However, the word "temporary" does not appear in Ito, and the Office has not explained why it considers these elements of Ito to be temporary elements as recited in claim 1, such that the Office has not identified wherein these facets of claim 1 are disclosed in Ito as required by *Levy*. Furthermore, it is submitted that these facets of claim 1 are not disclosed or suggested by Ito.

The Office considers the status field 22a of the SDL entry 22 in FIGS. 1C and 2 of Ito to be "a pointer indicating an area in which the temporary defect information is recorded" as recited in claim 1. However, according to column 10, line 30, through column 11, line 37, of Ito relied on by the Office, the status field 22a merely indicates whether the defective sector is replaced by a defective sector, rather than being a pointer indicating an area in which are recorded the fields 22b and 22c in FIGS. 1D and 2 of Ito, which the Office apparently considers to be "temporary

defect information comprising position information of a defect area and position information of a replacement area for replacing the defect area" as recited in claim 1. See column 10, lines 35-46, of Ito, which states as follows (emphasis added):

The status field 22a is used to indicate whether the defective sector is replaced by a replacement sector. The location of the defective sector is represented by, for example, the PSN of the defective sector. The location of the replacement sector is represented by, for example, the PSN of the replacement sector.

For example, the status field 22a may include a 1-bit flag 22a-1 and a reserved area 22a-2. For example, the 1-bit flag 22a-1 being "1" may indicate that the defective sector is not replaced by a replacement sector, and it being "0" may indicate that the defective sector is replaced by a replacement sector.

In explaining the rejection, the Office states "the status information indicates the location of defective sector 22b and location of replacement sector 22 [sic] 22c." However, as can be seen from the above paragraphs of Ito, the status field 22a is merely a 1-bit flag that indicates whether the defective sector is replaced by a replacement sector, rather than being a pointer indicating an area in which are recorded the fields 22b and 22c.

Furthermore, the field 22b in FIGS. 1D and 2 of Ito is not a defective sector as stated by the Office, and the field 22c in FIGS. 1D and 2 of Ito is not a replacement sector as stated by the Office. As shown in FIG. 2 of Ito, the data block c in the logical volume space 6a is a defective sector, and the #1 spare block in the first spare area 7 is a replacement sector that replaces the defective data block c as indicated by the first SDL entry 22 in the SDL 13. As can be seen from the above paragraphs of Ito, the field 22b in the first SDL entry 22 contains the PSN of the defective data block c, and the field 22c in the first SDL entry 22 contains the PSN of the replacement #1 spare block. Thus the rejection appears to be based on a misunderstanding of Ito by the Office, such that it is impossible for the Office to have established a *prima facie* case of anticipation with respect to claim 1.

Arguments similar to the above arguments were also presented in the second paragraph on page 7 of the Amendment in Response to Final Office Action of May 11, 2010, but the Office did not take note of these arguments and answer the substance of them in the Advisory Action of May 26, 2010, as required by MPEP 707.07(f).

On pages 2 and 3 of the Final Office Action of March 9, 2010, the Office states as follows:

Applicant states that the reference of ITOH [sic] et al [sic] does not teach or suggest a location where the temporary defect information is recorded. Applicant is directed to column 5, lines 9-28 and column 5, line 65, to column 6, line 6, on these paragraphs ITOH [sic] et al [sic] teaches the location information of defective area and location information for replacement area. Logically, without location information, the device cannot identify where is defective areas and where is the defective areas could be replaced. The reference in deed [sic], meet [sic] all of the issues as recited in the claims.

However, in the Response of November 27, 2009, the applicants did not state that "the reference of ITOH [sic] et al [sic] does not teach or suggest a location where the temporary defect information is recorded" as alleged by the Office. Rather, in the third paragraph on page 6 of the Response of November 27, 2009, the applicants stated that "Itoh [sic] . . . makes no reference or suggestion that this status field [22a] indicates a location where the temporary defect information is recorded, as recited in independent claim 1. Thus, what the applicants actually argued is that Ito's status field 22a does not indicate a location where the temporary defect information is recorded, and the Office did not take note of this argument and answer the substance of it in the Final Office Action of March 9, 2010, as required by MPEP 707.07(f). Furthermore, as explained in detail above, Ito's status field 22a is not "a pointer indicating an area in which the temporary defect information is recorded" as recited in claim 1.

Furthermore, "the location information of defective area and location information for replacement area" referred to in column 5, lines 9-28, and column 5, line 65, through column 6, line 6, of Ito relied on by the Office in the above passage from the Final Office Action of March 9, 2010, is merely the location information or PSN of the defective sector that is stored in the field 22b of the SDL entry 22 in FIG. 1D and 2 of Ito, and the location information or PSN of the replacement sector that is stored in the field 22c of the SDL entry 22 in FIG. 1D and 2 of Ito. The Office apparently considers this location information of Ito to be "temporary defect information comprising position information of a defect area and position information of a replacement area for replacing the defect area" as recited in claim 1. Accordingly, it is submitted that this location information of Ito cannot also be "a pointer indicating an area in which the temporary defect information is recorded" as recited in claim 1. It is submitted that Ito does not disclose or

suggest a pointer indicating an area in which this location information of Ito is recorded. As explained in detail above, Ito's status field 22a is not such a pointer.

In the Advisory Action of May 26, 2010, the Office states as follows:

Applicant states that the claims recited "write-once disc" and the reference is "rewritable recording medium". Applicant is directed to ITO et al's [sic] column 9, line 15, "the disk 1 may be any type of information recording medium, including DVD-RAM," which clearly means that the recording medium could be any types (DVD-ROM, DVD-RAM, CD-R, CD-ROM, etc., [sic]).

However, the sentence in column 9, line 15, of Ito relied on by the Office is part of the following passage in column 9, lines 15-17, of Ito (emphasis added):

A disk 1 is a rewritable information recording medium. The disk 1 may be any type of information recording medium, including a DVD-RAM.

It is submitted that it is readily apparent from this passage that the "any type of information recording medium" referred to in this passage is any type of rewritable information recording medium, particularly since the specific example of a DVD-RAM given is a rewritable information recording medium, and every single one of Ito's embodiments uses a rewritable disk. See column 3, line 2; column 9, line 15; column 15, line 64; column 16, lines 40 and 42; column 17; lines 11, 21, and 42; column 19, line 59; column 20, lines 21, 36, and 39; column 21, lines 32, 54, and 56; column 22, lines 7, 11, 16, 18, 37, 40, and 54; column 24, lines 28 and 59; column 25, lines 24, 26, and 40; column 26, lines 13, 33, 53, and 58; and column 27, line 27, of Ito. Accordingly, it is submitted that Ito does not disclose or suggest "[a] write-once disc with at least one record layer" as recited in claim 1.

On page 4 of the Office Action of August 31, 2009, the Office states "[c]laims 22 and 43 are rejected with the same reasons set forth in claim 1, above." However, it is submitted that independent claims 22 and 43 are patentable over Ito for at least the same reasons discussed above that claim 1 is patentable over Ito.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1, 4, 22-24, and 43 (i.e., claims 1, 22, and 43 discussed above and claims 4, 23, and 24 depending from claims 1 and 22) under 35 USC 102(b) as being unpatentable over be withdrawn.

Please charge any fees under 37 CFR 1.16, 1.17, and 41.20 that may be required for this paper only to Deposit Account 50-5113 in the name of North Star Intellectual Property Law, PC.

Respectfully submitted,

Date: June 9, 2010

By: /Randall S. Svihla/
Randall S. Svihla
Registration No. 56,273

NSIP Law
1156 15th Street NW, Suite 603
Washington, DC 20005
Tel: (202) 429-0020
Fax: (202) 315-3758
CYP/RSS